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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/650,432

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Sylvana Miceli

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02/14/2006

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EXAMINER

MAI, HUY KIM

ART UNIT

PAPER NUMBER

2873

DATE MAILED: 02/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/650,432

Applicant(s)

MICELI, SYLVANA

Examiner

Huy K. Mai

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-12 is/are rejected.
7) ☒ Claim(s) 13-15 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 28 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Huy K. Mai
Examiner

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 10, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Breuker, Jr. (of record).

The limitations in claim 1 are shown in Breuker, Jr.'s Figs. 1-4, pages 1-2. Breuker, Jr. discloses a pair of eyeglasses comprising a frame 12 having a pair of lens supports for receiving a pair of eyeglass lenses 17 in a vertical plane; a pair of temples 14, each said temple being hingedly secured to a respective lens support near a bottom of said frame and extending in an upwardly angled direction from said frame; and a nose piece 11,13 on said frame between said lens supports for resting on a nose of a user with said lens supports spaced from the eyes of the user wherein the portion 18 of the temple 14 has no obstacle to the user's eyes whereby the user can access to eyes. The recitations "to permit access to the eyes of the user laterally of said frame for the application of makeup" are intended use since there is no obstacle of the portion 18 on the side of the wearer is capable of performing the intended use.

Regarding claim 10, the recitations in claim 10 are similar to those in claim 1, except for the lenses of selective diopter. Breuker, Jr. discloses the corrective or prescriptive character of the lenses used will be as required by the particular individual. Thus the Breuker, Jr.'s lenses inherently include selective diopter for each particular individual.

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Regarding claim 12, the recitations in claim 12 are similar to those in claim 1 except for the nose piece on said frame between said lens supports for resting on a distal end of a nose of a user. It is commonly known to wearers that the nose piece of spectacles can slidably position along the nose upon the wearers' desirability, for example, a wearer is reading a book; he/she can position the nose piece near the distal end of the wearer's nose. Thus, a combinations of the Breuker's eyeglasses with the nose piece resting on a distal end of a nose of a user would not made claim patentably distinct from the Breuker's reference.

NOTE: If the feature "between said frame and the eyes" (claim 12, lines 8-9) changes to – between said lenses and the eyes--, and combines with "...resting on a distal end of a nose...", such a change would appear claim 12 allowable over the Breuker reference, i.e., lines 5-12 of claim 12 should read: --a pair of temples, each said temple being hingedly secured to a respective lens support near a bottom of said frame and extending in an upwardly angled direction from said frame to rest on the ears of a wearer with said pair of lens supports spaced away from the face of the wearer to allow a makeup applicator to be inserted between said **lenses** (emphasized) and the eyes of the wearer; and a nose piece on said frame between said lens supports for resting on a **distal end** (emphasized) of a nose of a user with said lens supports space from the eyes of the user to permit access to the eyes of the user laterally of said frame for the application of makeup.--.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Breuker, Jr. in view of Kneier (of record).

The recitations in claims 2 and 11 are shown in the Breuker, Jr. reference as discussed above, except for the shape of the lens and/or lens supports having a greater height than width thereof. Kneier discloses a pair of eyeglasses for the application of makeup wherein the lens has a greater height than width thereof. Therefore, it would have been obvious at the time the invention was made to those skilled in the art to modify the Breuker, Jr.'s device in light of Kneier's teachings by forming the lens has a greater height than width thereof for the same purpose disclosed by Kneier as well the same intended use in the Breuker, Jr. references as discussed above.

5. Claims 3-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Breuker, Jr. in view of Hirschman (of record).

Regarding claims 3,4, Breuker, Jr. discloses the claimed invention as discussed above, except for the curved end piece being adjustable as claimed. Hirschman, in Fig. 3, discloses a pair of eyeglasses wherein the curved end piece 40 is adjustable for the purposes of proper fit the eyeglasses on the user's ear. Since Breuker, Jr. and Hirschman are both from the same filed of endeavor, the purpose disclosed by Hirschman would have been recognized in the pertinent art of Breuker, Jr.. It would have been obvious at the time the invention was made to those having ordinary skill in the art to modify the Breuker, Jr.'s curved end piece by forming an adjustable curved end piece as disclosed by Hirschman for the purpose of proper fit the eyeglasses on the

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user's ear. Such a modification would not change the scope of the invention in the Breuker, Jr. reference.

Regarding claims 6,7, the recited limitations in claims 6,7 are similar to those in claims 3,4. The above discussions applied to claims 3,4 would apply to claims 6,7. Breuker, Jr. is silent in discussion the hinged axis of the rectilinear portion 18 related to the temple arm 15. It appears in Figs. 1,5 that the hinged axis is vertical or near vertical. It would have been obvious to an artisan to vary the hinged axis in the Breuker, Jr.'s device to a vertical axis as a matter of engineering choice so as the temple hingedly secured to the lens support between the open and close positions. Such a modification also would not change the scope of the invention in the Breuker, Jr. reference.

Regarding claims 5,8,9, absence in showing the new or unobvious results and the reasons why the mounting block either extends laterally or transversely from the respectively lens support, it would have been an obvious engineering choice to form such a mounting block extends laterally of transversely from the respectively lens support so as hingedly secured to the lens support between the open and close positions. Such a modification also would not change the scope of the invention in the Breuker, Jr. reference.

Allowable Subject Matter

6. Claims 13 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. Claims 14 and 15 are objected to as being dependent upon the above objected claim.

Response to Arguments

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8. Applicant's arguments filed Dec. 13, 2005 have been fully considered but they are not persuasive. The applicant argues in page 2 of his remark that "the examiner offers no evidence , but only speculate as this capability". This argument is not true. The Breuker reference discloses 'the portion 18 of temple 14 has no obstacle to the user's eye whereby the user can access to the eye as stated in the Office action. Such the teachings of Breuker is the evidence to support for the capable of performing the intended use. On the other hand, the applicant does not explain the reasons why the similar structure with claimed invention in claims 1 and 10, the Breuker's eyeglasses does not permit access to the eye, but the applicant's does.

The applicant argues in page 3 of his remarks that "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art" and cites the case law: *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990); and continues argues that "To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognize by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient" and then cite the case law *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). These arguments are not true. The examiner provides the basis in fact and/or technical reasoning as stated in the action "the portion 18 of the temple 14 has no obstacle to the user's eyes whereby the user can access to eyes". This fact is sufficient to conclude of capable of performing the intended use. The examiner provide the reasons for such capable of performing the intended use by the statement

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“since there is no obstacle of the portion 18 on the side of the wearer”. The Breuker discloses no obstacle of the portion 18 on the side of the wearer as the same as the applicant does. The same structure would provide the same capable of performing. The applicant does not explain the reasons why the similar structure with claimed invention in claims 1 and 10, the Breuker’s eyeglasses does not permit access to the eye, but the applicant’s does. The evidence “the portion 18 of the temple 14 has no obstacle to the user’s eyes” is clearly support for the “capable of performing the intended use” instead of “the missing descriptive matter” as argued by the applicant. For the above reasons, the rejection of claims 1,10 and 13 as being anticipated over Breuker is proper.

In response to the reject of claim 2, the applicant argues that “There is no description in Kneier as to the length and width of the lenses 24. Further, since the drawings are not drawn to scale...”. In fact, the Kneier’s Figs. 1 draw the lenses 24 in scale in relationship with the wearer’s face. Such the “scale” relationship between the shape of the wearer’s face including nose, eyes, eyebrow and the distance from the nose to the cheek and the size of the lenses 24 is sufficient for providing the scale of the length and width of the lenses 24.

In response to the rejection of the other claims, the applicant states that a rejection of claim over Breuker in view of a secondary reference is not warranted pursuant to the provisions of 35 USC 103. The applicant doubts the rejection being “not warrant pursuant to the provisions of 35 USC 103” is not positive response to point out the patentable features distinct from the combination between Breuker reference and the secondary references.

For the above reasons, the rejection to other claims is maintained.

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Regarding claim 12, the examiner suggests to change the word “frame” to --lenses—as discussed above.

Claim 13 is object.

Claims 14-15 are objected as being dependent upon the objected claim 13.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huy Mai whose telephone number is (571) 272-2334. The examiner can normally be reached on M-F (8:00 a.m.-4:30 p.m.).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky L. Mack can be reached on (571) 272-2333. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1562.

A handwritten signature in black ink, appearing to read 'Huy Mai'.

Huy Mai

Primary Examiner

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HKM/

February 9, 2006